

REMARKS/ARGUMENT

Claims 1 and 3-18 are pending. Claims 1, 2 and 4-18 have been amended.

Claims 1, 4, 5, 7-12 and 14-18 are the independent claims.

Applicant notes with appreciation the indication that Claims 6-11 and 13 would be allowable if rewritten so as not to depend from a rejected claim. Claims 7-11 have been so rewritten, with minor other changes related solely to form, and are believed clearly now in condition for allowance.

Claims 1, 5 and 14-18 were rejected under 35 U.S.C. § 102(a) U.S. Patent 6,125,144 (Matsumura et al.). Claims 2-4 were rejected under 35 U.S.C. § 103(a) over Matsumura. Claim 12 was rejected under 35 U.S.C. § 103(a) over Matsumura in view of U.S. Patent 4,651,206 (Ohki). Applicant traverses and submits that the independent claims are patentable for at least the following reasons.

Claim 1 is directed to a moving picture encoding apparatus for encoding successive input image signals, comprising: block significance determining means for determining block significance for each block as an encoding unit of the input image signals according to predetermined evaluation indices; map generating means for generating, according to the block significance, a refresh map signal representing priority of refresh processing for each block; adaptive refresh signal generating means for referring to refresh priority indicated by the refresh map signal and an allowed number of blocks for refresh processing in a frame to be

encoded, selecting a block for refresh processing, and generating a refresh signal specifying the block for refresh processing; and moving picture encoding means for conducting an intra-frame encoding operation for a block specified by the refresh signal and for appropriately selecting and executing an intra-frame encoding operation or an inter-frame forecast encoding operation for a block not specified by the refresh signal. The block significance determining means calculates for each block a block feature which is a quantity representing a feature of signal distribution of the block and a visual characteristic of the block. This feature was originally recited in claim 2.

In the rejection to claim 2, the Examiner refrained from taking the position that calculation for each block of a block feature which is a quantity representing a feature of signal distribution of the block and a visual characteristic of the block is shown in Matsumura. Applicant agrees that this is not taught or suggested in Matsumura. However, the Examiner took “official notice” that “calculating signal distribution of the block and a visual characteristic (luminance) of the block . . . is conventionally well known in the art.”

In the first place, even if this were deemed, for the purpose of argument, to be true, no motivation has been provided to modify the primary reference to include these features. As is well-settled, to set forth a prima facie case of obviousness, the Examiner must show that there is some motivation in the prior art to make the proposed modification. Since this has not been done here, no prima facie case has been established for at least this reason.

Further, the MPEP specifically states that taking official notice of the type taken in the Office Action is improper and not permitted. In accordance with U.S. Patent Office practice, the Examiner can only rely upon such official notice where the facts asserted are "capable of instant and unquestionable demonstration as being well-known". MPEP Section 2144.03A. For this reason, "in limited circumstances, it is appropriate for an Examiner to take official notice of facts not in the record or to rely on 'a common knowledge' in making a rejection; however, such rejections should be judiciously applied." MPEP 2144.03.

The Office Action states that certain claimed features are known in the art. However, the issue of whether the elements, categories, etc., are known in the art is exactly the type of thing that official notice may *not* be relied upon for. See MPEP 2144.3A ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The *facts constituting the state of the art* are normally subject to the possibility of rational disagreement among reasonable men and *are not amenable to the taking of such notice.*" Citing *In re Eynde*, 480 F2d 1364,1370 (CCPA 1973) (emphasis supplied).

In view of the fact that MPEP specifically states that official notice may not be used with regard to the state of the art, the Examiner is requested in the next Office Action to provide evidence that the feature in question is known in the prior. Of course, such evidence should have been provided in the first place to support a finding of obviousness. In addition, if the rejection is to be maintained, a motivation to make the modification of Matsumura must be provided. Further, since the feature was previously recited and improperly rejected in claim

2, the next Office Action cannot properly be made final, since the above arguments would have been valid as to the rejection of claim 2 prior to this amendment.

Independent claims 5 and 14-18 also recite the feature discussed above in connection with claim 1 and are believed patentable for at least the same reasons.

Claim 4, which is now rewritten in independent form, recites, inter alia, that the block significance determining means calculates for each block a block feature which is a quantity indicating power of a signal obtained by passing intra-block signals through a band-pass filter; and compares the block feature with one or more threshold values and thereby generating block significance for each block. In the rejection to claim 4, the Examiner took official notice that a "band pass filter is conventionally well known in the art." However, even if this were deemed, for the purposes of argument, to be true, no prima facie case of obviousness has been set forth because no motivation has been shown, in the prior art, for making the modification to Matsumura.

Moreover, as was stated above, the use of official notice to show what constitutes the state of the art is improper and not permitted. See *Id.* For this additional reason, no prima facie case has been set forth with regard to claim 4 and its allowance is requested.

Claim 12 recites, inter alia, that the refresh history determining means includes a map history memory that refers to the refresh map signal from the map generating means and

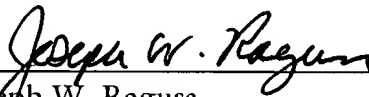
the refresh signal from the adaptive refresh signal generating means, thereby updating history, beginning at a start of encoding processing, of a refresh map, and storing therein the refresh map. There is no teaching or suggestion in Matsumura of this feature. Accordingly, claim 12 is believed patentable over the cited art.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Dated: December 5, 2003

Respectfully submitted,

By 
Joseph W. Ragusa

Registration No.: 38,586
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant